



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

2/c

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/163,713	09/30/98	LUSTIG K	T97-012-1

HM12/0315

RICHARD ARON OSMAN
SCIENCE & TECHNOLOGY LAW GROUP
75 DENISE DRIVE
HILLSBOROUGH CA 94010

EXAMINER

PAK, M

ART UNIT	PAPER NUMBER
----------	--------------

1646

8

DATE MAILED: 03/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/163,713

Applicant(s)

Lustig et al.

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on Feb 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) 12-16 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 and 17-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The preliminary amendment filed 5 February 2000, Paper No. 7 has been entered.

2. Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that antibodies are made for their specificity and it would be illogical to intentionally make a non-specific antibody by immunizing with a mixture rather than the uncombined components of the mixture. However, it should be noted that antibodies are generated against unpurified mixtures. Furthermore, the claims are not directed to a specific mixture which was mixed together from a purified form. The mixture can be used to further purify the receptors, candidate agent, or sensors.

The requirement is still deemed proper and is therefore made FINAL.

3. The Declaration under 37 CFR 1.132 filed 15 February 2000 is insufficient to overcome the rejection of claims based upon Baylor School of Medicine as set forth in the corresponding PCT application for the reasons set forth below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5, 8-11, and 17-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method using a sensor comprising specific sequence, does not reasonably provide enablement for a claimed method using a sensor which comprises less than 6 amino acids. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 1-5, 8-11, and 17-31 encompass a method using the peptide sensor of two amino acids because of the limitation "fewer amino acids". However, the specification does not teach how to use a method using the peptide sensor of two amino acids. The specification on pages 5-6 disclose Table 2 of which the smallest fragment is 5 amino acids. Furthermore, Table 2 does not teach whether the examples worked or not because the results cannot be interpreted without further explanation. The state of

the art at the time of the invention is disclosed by the Declaration of Steven L. McKnight who teaches that it was unpredictable to use smaller peptides. One of ordinary skill in the art would require undue experimentation to practice the claimed method with a sensor of two amino acids.

Claim Rejections - 35 USC § 112, 2nd paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5, 8-11, and 17-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "comprises 24 or fewer amino acids" which is confusing because term "comprises" and "fewer amino acids" seem contradictory. Claims 2-5, 8-11, and 17-31 are dependent on claim 1.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Serial Number: 09/163,713
Art Unit: 1646

4

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-11 and 17-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Baylor College of Medicine (WO 97/10337).

BAYLOR COLLEGE OF MEDICINE(BAYLOR) teach the SRC-1 polypeptide which meets the limitation of the peptide sensor in claims 1-11 and 17-30 because the SRC-1 comprises the sequence of SEQ ID NO:1(pages 7-8, 16-18, 46-59, and 68-74). BAYLOR teach the methods of sensor binding to nuclear hormone receptor with a ligand (pages 5, 16-21, 46-59, 68-74 83-85, and 88-92).

Claim 1 limitation to "comprising 24 or fewer amino acids" encompasses a peptide sensor comprising 1 amino acid in common with polypeptide of Baylor because the term "comprising".

The Declaration of Steven L. McKnight is not sufficient to overcome the rejection because the unexpected result does not apply in the 35 U.S.C. 102(a) rejections.

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Serial Number: 09/163,713
Art Unit: 1646

5

Official papers filed by fax should be directed to (703) 308-4242.
Faxed draft or informal communications with the examiner should be directed to
(703) 308-0294.

Any inquiry of a general nature or relating to the status of this
application or proceeding should be directed to the Group receptionist whose
telephone number is (703) 308-0196.

Michael D. Pak

Michael Pak
Primary Patent Examiner
Art Unit 1646
5 March 2000